

REMARKS

Election

In response to the Restriction Requirement set forth in the Office Action of September 1, 2005, applicants hereby elect Group I, claims 1-41, 57-61, and 66, drawn to compounds and compositions of formula I.

As for Group II, upon determination that subject matter of Group I is allowable, applicants will request rejoinder of the claims of Group II, pursuant to MPEP §821.04.

In response to the Election of Species Requirement set forth in the Office Action dated August 5, 2005, applicants hereby elect the following species: *N*-(3-ethoxy-4-methoxyphenyl)-*N*-(3-pyridylmethyl)-4-aminobenzoic acid. See, e.g., page 19, line 13; page 78, lines 1-2; and page 172, line 22. Claims 1, 7, 21, 22, 111, and 112 read on the elected species.

It is applicants' understanding that, following this election, examination will proceed in accordance with MPEP §809.02(c). In particular, it is applicants understanding that, upon determination that the elected species is allowable, examination will be extended to other species and further, upon determination that a generic claim is allowable, applicants will be advised that the claims drawn to the non-elected species are no longer withdrawn. See, MPEP §809.02(c)(B)(1). With respect to the initial scope of examination, applicants suggest that the Examiner examine the scope of claim 1 in which R³ is heteroarylalkyl and R⁴ is aryl.

Regarding the Examiner's comments at pages 4-5 of the Office Action, and the citation of *In re Harnisch* and *Ex parte Hozumi* at page 3 of the Office Action, applicants respectfully submit that 35 USC §121 does **not** permit restriction within a single claim (except in one specific circumstance described below) as clearly indicated by the court in *In re Weber et al.*, 198 USPQ 328 (1978).

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If,

however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.

It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis. [*Weber* at 331-332]

The effect of restriction within a single claim is the same as a rejection. 35 USC §121 does not give the Commissioner authority to require that a single claim "be divided up and presented in several applications" and thus deny the Applicant the right to have that single claim considered on its merits. This is exactly the action that the Court in *Weber* stated was not permitted under 35 USC §121. Such action by an Examiner would violate "the basic right of the Applicant to claim his invention as he chooses." [*Weber* at 332]

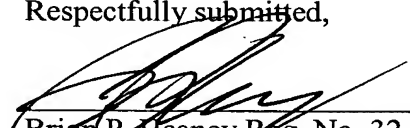
The claims here are Markush claims. MPEP §803, entitled "Restriction - When Proper," states that "[i]nsofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria are set forth in MPEP §803.02." The latter section of the MPEP states that: "[s]ince the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention." Thereafter, the MPEP cites *In re Harnish*, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d (Bd. Pat. App. & Int. 1984).

These two cases, *Harnish* and *Hozumi*, both deal with improper Markush rejections. Thus, in the case of Markush claims, refusal by the Office to examine that which the applicants regard as their invention, by restricting within a Markush claim, must be a refusal based on an improper Markush rejection. In both *Harnish* and *Hozumi*, the Court and the Board, respectively, decided that the Markush groups in question were **not improper**, and therefore restriction within a claim was not permitted. Thus, in the case of a proper Markush grouping, restriction within a claim is not permitted.

In view of the above remarks, examination should proceed in accordance with MPEP §803.02.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: MEMORY-28

Date: September 22, 2005